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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/970,547 | 10/03/2001 | Glen Jorgensen | 18405-115 | 1371 |
| 30623 | 7590 | 04/06/2004 | EXAMINER | |
| MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111 | | | SORKIN, DAVID L | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1723 | | |

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/970,547 | JORGENSEN ET AL. |
| | Examiner | Art Unit |
| | David L. Sorkin | 1723 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16, 18, 19, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 2, 4-16, 18, 19, 35 and 36 is/are rejected.
- 7) Claim(s) 3 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-16, 18, 19, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Juhasz et al. (US 3,503,326). Note: regarding claim preambles of claims 1, 35, and 36, particularly, the statement of intended use "for a continuous flow centrifuge", it has been held that, "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation" *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Note also regarding the statements of what passages are "for" and/or "dedicated for", "the manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967). Further regarding claims 1 and 36, Juhasz ('326) discloses an apparatus comprising a plurality of axially aligned processing chambers (10) and expressor chambers (13), each chamber including an axial opening (see col. 2, lines 41-45; Fig. 1) housing a central hub (6), wherein a respective central hub of a respective chamber includes at least one first dedicated passage (8) dedicated for communication with the respective chamber and at least one second passage (7) dedicated for communication with another processing chamber or expressor chamber.

Regarding claim 2, said processing chambers and said expressor chambers are alternately arranged (see especially Figs. 2 and 3, although the embodiment of Fig. 1 could also be considered "alternately arranged", if the pair of subchambers marked "13", which are in fluid communication, are considered a single chamber). Regarding claim 4, the chambers are flexible and expandable (see col. 3, lines 71-75). Regarding claim 5, the processing and expressor chambers are capable of releasably contacting each other at circumferential portions of the chamber when the expressor chambers are filled with an expressor fluid (see Fig. 1). Regarding claim 6, the central hubs are constructed and arranged to prevent construction of an apparatus having two adjacent processing chambers (see Fig. 1). Regarding claim 7, the central hubs are constructed and arranged to prevent construction of an apparatus having two adjacent expressor chambers (see Fig. 1). Regarding claim 8, the central hubs are constructed and arranged to define multiple passage ways (7,8) for fluid communication. Regarding claim 9, the central hubs comprise a number of passages for fluid communication that is at least equal the number of chambers in the apparatus (note the at least three radial passage "8" for each hub as seen in, for example, Fig. 1). Regarding claim 10, a plurality of weld rings (the flanged portions of 6) are disclosed. Regarding claim 11, the processing chambers and expressor chambers are substantially the same (generally annular) shape (see drawings). While claim 12, is considered open to being an intended use, since the chambers are intended to change size, the processing chambers being smaller than the expressor chambers is depicted, for example, in Fig. 1. Regarding claim 13, the processing chambers and expressor chambers are substantially circular

(see col. 2, line 41). Claims 14 and 15 are open to being intended uses, due to the flexible materials defining the chambers. The processing chambers of Juhasz ('326) may have a smaller diameter than the expressor chambers, as seen in Fig. 1, or the same diameter, as incoming fluid expands the processing chamber, as described in col. 3, lines 71-75). Regarding claim 16, the processing and expressor chambers are constructed from two sheets of flexible material (3 and/or 4) sealed at an outer circumference and an inner circumference, wherein the inner circumference is adjacent the axial opening (see Fig. 1). Claim 18 further requires an "entry hub". The left-most hub 6 in Fig. 1 is considered anticipate this limitation and is capable of being used to allow entry of fluid from an external pathway as stipulated in the claim. Claim 19 is considered not to further structurally limit the claimed apparatus, because it only recites aspects of a "fluid pathway" which is external to the claimed device (as stipulated by parent claim 18). Further regarding claim 35, Juhasz ('326) discloses an apparatus comprising a plurality of axially aligned processing chambers (10 and/or 13), each chamber including an axial opening (see col. 2, lines 41-45; Fig. 1) housing a central hub (6), wherein a respective central hub of a respective chamber includes at least one first dedicated passage (8) dedicated for communication with the respective chamber and at least one second passage (7) dedicated for communication with another processing chamber.

Allowable Subject Matter

3. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. The closest prior art is Juhasz et al. (US 3,503,326); however, Juhasz ('326) fails to disclose the processing chambers each being within a corresponding expressor chamber.

Response to Arguments

4. Applicant states that Juhasz ('326) fails to disclose a central hub including "dedicated passageways for other chambers". Applicant is reminded that "the manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967). Hubs (6) including passages 7 and 8 are considered to anticipate all the hub limitations of apparatus claim 1.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Sorkin

David L. Sorkin
Examiner
Art Unit 1723